

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

AMERICAN INSTITUTE OF PHYSICS,
and BLACKWELL PUBLISHING, LTD.

Plaintiffs and Counterclaim Defendants,

v.

WINSTEAD PC, and JOHN DOES NOS.
1-10,

Defendants,

No. 3:12-cv-01230-M

and

THE UNITED STATES PATENT AND
TRADEMARK OFFICE,

Intervening Defendant and Counterclaim
Plaintiff.

**MEMORANDUM OF LAW IN SUPPORT OF USPTO'S MOTION FOR JUDGMENT ON
THE PLEADINGS OR PARTIAL SUMMARY JUDGMENT ON ITS FAIR USE
DEFENSE AND COUNTERCLAIM**

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The United States Patent and Trademark Office ("USPTO") submits this memorandum of law in support of its motion, pursuant to Fed. R. Civ. P. 12(c) or, in the alternative, Fed. R. Civ. P. 56(a), for judgment on its fair use defense and declaratory judgment counterclaim. For the reasons set forth below, the Court should grant the motion.

INTRODUCTION

Plaintiffs allege that the defendant Winstead law firm infringed their copyrights in scientific, medical, and technical articles (referred to herein as "non-patent literature" or "NPL") when it made copies of them in the course of their representation of clients. As made clear in the

Court's November 20, 2012, hearing, this case specifically involves Winstead's copying and use of the specified NPL in connection with its representation of clients in proceedings before the USPTO. *See* Nov. 20, 2012, Hearing Transcript (Doc. No. 46), at pp. 9-13, 18. Because of the obvious interest of the USPTO in this case and its potential ramifications for its patent examination and review procedures, it intervened as a defendant and, on August 17, 2012, responded to the original complaint by asserting a First Defense that:

The copying of copyrighted NPL and distribution thereof, which copying and/or distribution is necessary and incidental to the filing and prosecution of a U.S. patent application and/or the conduct of other USPTO proceedings concerning or relating to the scope or validity of any issued U.S. Patent, including copies of NPL actually submitted to the USPTO and copies of NPL initially considered but ultimately rejected for inclusion in submissions to the USPTO, by or at the direction of patent applicants, patentees, patent challengers, and/or their representatives, such as defendant Winstead constitutes a fair use of such copyrighted works under 17 U.S.C. § 107, and therefore is not an infringement of copyright.

USPTO Answer (Doc. No. 36), at pp. 1-2. The USPTO also asserted a counterclaim seeking a declaratory judgment using the exact same language. *Id.* at 10-16. Plaintiffs answered. Doc. No. 38. After the Court dismissed the original complaint, plaintiffs amended. Doc. No. 44.

The USPTO then re-asserted its fair use defense and counterclaim. Doc. No. 55. The USPTO now moves, pursuant to Rule 12(c), for judgment on the pleadings, or, in the alternative, pursuant to Rule 56(a), for partial summary judgment, on its First Defense and Declaratory Judgment Counterclaim.

I. The USPTO seeks judgment on its defense and declaratory judgment counterclaim concerning application of the fair use factors to copies of NPL made in connection with USPTO proceedings.

In this motion, the USPTO requests judgment that, on balance, the statutory factors favor fair use where participants in proceedings before the USPTO make necessary and incidental

copies of published factual articles for the facts they disclose, and in which the applicable regulations mandate disclosure of material prior art publications, in order to ensure that the USPTO can efficiently make decisions that comport with the constitutional and statutory requirements for patentability.

Winstead's motion to dismiss the Amended Complaint discloses four kinds of copies of the NPL at issue were made: (a) copies sent to the firm by clients; (b) copies submitted to the USPTO with patent filings; (c) an archival copy of submitted NPL residing in Winstead's files; and (d) copies that were part of PTO filings, copies of which filings were transmitted to clients. Doc. No. 56, at pp.10-11. Plaintiffs have withdrawn any claim that categories (b) and (c) are unlawful. Am. Compl. ¶ 1 (Doc. No. 44). And there can be no reasonable dispute that category (a) (NPL sent from the client to Winstead) and category (d) Copies included in Winstead's patent filings, which filings Winstead in turn provided to the client fall comfortably within the standard advocated in the USPTO's fair use defense and counterclaim. Thus, judgment as to the USPTO's First Defense and Counterclaim (and, as Winstead's motion makes clear, dismissal of the amended complaint) is appropriate.

Rule 12(c) "permit[s] the consideration and determination of the legal issues submitted." *Security Life & Accident Ins. Co. v. United States*, 357 F.2d 145, 150 (5th Cir. 1966) (Rule 12(c)); *see also Mergens v. Dreyfoos*, 166 F.3d 1114, 1117 (11th Cir. 1999) ("Judgment on the pleadings is appropriate where no issue of material fact remains unresolved and the moving party is entitled to judgment as a matter of law."). Similarly, a Rule 56(a) motion for summary judgment is an appropriate vehicle "to decide issues of law when there are no material facts in dispute that need to be decided by the trier of fact." *Mitchell v. City of Moore*, 218 F.3d 1190, 1200 (10th Cir. 2000); *see Victoria L. v. District School Bd.*, 741 F.2d 369, 372 (11th Cir. 1984)

(“Summary judgment procedure decides only issues of law and therefore does not offend a plaintiff’s right to have his evidence heard.”) (citation omitted). Thus, either a Rule 12(c) or 56(a) motion can be appropriate when directed to a legal issue and not implicating disputed material facts. *See, e.g., U.S. ex rel. Simmons v. Zibilich*, 542 F. 2d 259, 260 n.3 (5th Cir. 1976) (per curiam).

II. Overview of the patent examination process

An inventor who seeks to protect his or her invention may file a patent application with the USPTO. *See, e.g., Christopher A. Cotropia, Modernizing Patent Law’s Inequitable Conduct Doctrine*, 24 BERKELEY TECH. L.J. 723, 729 (2009) [hereinafter “Cotropia”].¹ The application is assigned to a patent examiner with expertise in the technical field to which the application is drawn. *See id.* at 730. The examiner is charged with evaluating whether the application satisfies the requirements of patentability set forth in the Patent Act: The invention must fall within one of the four statutory categories of subject matter, that is, a useful process, machine, manufacture, or composition of matter; it must be novel; it cannot have been obvious to a person of ordinary skill in the art at the time of invention; and the application must adequately disclose the invention to the public. 35 U.S.C. §§ 101, 102, 103 & 112. *See Cotropia*, at p. 730.

An examiner requires sufficient information to determine whether an application satisfies the conditions of patentability. Common types of information that an examiner reviews are prior-issued patents in the relevant technical field and, as relevant to this case, scientific, scholarly, and technical articles, *see id.* at 730-31, often called “non-patent literature” or “NPL.” The Patent Act specifies the primary role that NPL plays in the evaluation of patentability.

¹ Available on-line at <http://ehis.ebscohost.com/ehost/pdfviewer/pdfviewer?sid=2de693da-034e-4818-aba5-e16eabb42961%40sessionmgr4&vid=2&hid=4> (last checked Feb. 27, 2013).

Section 102, for example, elaborates on the novelty requirement by precluding the issuance of a patent if “(a) the invention was known or used by others in this country, or patented or *described in a printed publication* in this or a foreign country, before the invention thereof by the applicant for patent, or (b) the invention was patented or *described in a printed publication* in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States” (Emphases added.)² Section 103(a) provides that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The reference to “prior art” includes NPL.

While an examiner conducts his or her own search for relevant prior art, including NPL, during examination, a critical resource for relevant information is the applicant himself who is often an expert in the field and often in the best position to be aware of closely related NPL. *See* Cotropia, at pp. 751, 754-55. 37 CFR § 1.56 imposes upon patent applicants (and their representatives) a duty to disclose “all information material to patentability”:

(a) A patent by its very nature is affected with a public interest. *The public interest is best served*, and the most effective patent examination occurs when, at the time an application is being examined, *the Office is aware of and evaluates the teachings of all information material to patentability*. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a *duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section*. . . . The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner

² The recently-enacted Leahy-Smith America Invents Act amended Sections 102 and 103. *See* Pub. L. No. 112-29 § 3, 125 Stat. 285-88 (2011). The amendments do not affect this case.

prescribed by §§ 1.97(b)-(d) and 1.98. . . . *The Office encourages applicants to carefully examine:*

. . .

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office (emphases added).

To promote full satisfaction of the duty to disclose information, the USPTO's regulations encourage patent applicants to file "an information disclosure statement" ("IDS") along with their application. 37 CFR § 1.51(d). An applicant must list in an IDS all publications that the applicant, in fulfillment of the duty of disclosure in 37 CFR § 1.56, wants the USPTO to consider (*see* 37 CFR § 1.98(a)(1)); provide a copy of each such publication (*see id.* § 1.98(a)(2)(ii)); and, in the case of foreign-language publications, concisely explain the publication's relevance to the patentability of the alleged invention (*see id.* § 1.98(a)(3)(i)).

The potential materiality of information disclosed in a given piece of NPL is not always immediately apparent. This is one reason why most patent applicants hire attorneys or patent agents to prosecute their applications before the USPTO. A patent attorney or agent identifies what information is material and must be submitted to the USPTO, much like a trial lawyer decides when authority must be cited in a brief to satisfy the duty of candor to the court, and a scientist determines whether certain data is statistically significant and could affect a research study's integrity. This is an exercise of study and judgment that requires the culling of information ultimately deemed material to patentability from a larger universe of information related to the invention, but ultimately deemed, immaterial. *See Cotropia*, at pp. 757-59.

Relatedly, the drafting of claims for inclusion in the filed application is typically an iterative process: During the drafting process, a patent application's claims are likely to change as the participants in the process gain a fuller understanding of the teachings disclosed in the prior art,

and, as a result, understand and refine the scope of the claimed invention accordingly. This exercise requires close consultation between patent attorneys and agents and the client-inventor, who is likely familiar with the invention and the relevant field of art. *See id.* at 759.

To help ensure the thoroughness of the USPTO's examination process, a newly-enacted provision of the America Invents Act, codified at 35 U.S.C. § 122(e), permits any third party to submit to the USPTO printed publications "of potential relevance to the examination of the application." And third parties may also challenge an issued patent by requesting *ex parte* reexamination, post-grant review, and *inter partes* review. *See generally id.* §§ 301-07, 311-19, 321-29. These provisions similarly require third-party submitters to study and determine whether the prior art they have found is relevant to the application's patentability and, therefore, appropriate for submission to the USPTO. *See, e.g., id.* §§ 301, 312(a)(3)(A), 322(a)(3)(A).

In this case, the plaintiffs allege that patent applicants, patentees, and their legal representatives infringe copyrights when making unlicensed copies of NPL while determining whether to submit a particular NPL item to the USPTO. In their original complaint, the plaintiffs alleged that the very submission of NPL to the USPTO without a license is copyright infringement. In their amended complaint, the plaintiffs excluded copies of NPL submitted to the USPTO and one archival copy of that submission. The amended complaint still encompasses, however, any other copies made during the process of evaluating and selecting NPL to be submitted to the USPTO.

III. Necessary and incidental copying and distribution is fair use.

A weighing of the fair use factors demonstrates conclusively that fair use exists when patentees, patent applicants, and their attorneys and patent agents (collectively referred to as "Participants" at times in this brief) engage in unlicensed copying and distribution of NPL that is

necessary and incidental to the filing and prosecution of a U.S. patent application or the conduct of other USPTO proceedings concerning or relating to the patentability of any issued U.S. Patent. Such fair use activities include not only the copying and distribution of NPL actually submitted to the USPTO (which plaintiffs no longer accuse), but also copies of potentially material NPL which the law firm: received and retained from the client; initially considered but ultimately rejected for inclusion in submissions to the USPTO; retained as part of the law firm's archival copy of a USPTO submission; and sent to a client as part of the client's archival copy of its USPTO submission.³ Because those activities constitute fair use of copyrighted works under 17 U.S.C. § 107, they cannot be an infringement of copyright. As explained in detail below:

- Such uses benefit the public interest in an efficient and accurate government patent system;
- Participants in USPTO proceedings do not commercially exploit or re-sell the copied material or otherwise directly benefit from the copies;
- The copies are integrated into larger submissions to the USPTO made for purposes other than those that prompted the initial creation of the articles;
- Such copies do not usurp or compete in any primary commercial market for which the articles were created; and
- Courts routinely hold that copies made in connection with government proceedings constitute fair use.

A. Fair Use Generally

“Fair use was traditionally defined as a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985) (citation omitted). Particularly

³ This also includes any temporary copies—both visible and “behind the scenes” copies—that a law firm’s computers make when individual employees make, or send, or view copies of the NPL.

pertinent here, the Supreme Court has also made clear that “*the author’s consent to a reasonable use of his copyrighted works had always been implied by the courts as a necessary incident of the constitutional policy of promoting the progress of science and the useful arts*, since a prohibition of such use would inhibit subsequent writers from attempting to improve upon prior works and thus frustrate the very ends sought to be attained.” *Id.* (citations, brackets, and ellipses omitted; emphasis added). Specifically, the fair use statute provides:

[T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work

17 U.S.C. § 107. The preamble of section 107 provides “general guidance about the sorts of copying that Congress most commonly had found to be fair uses,” and its list of certain types of commonly-found fair uses is not exclusive, but illustrative. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577-78 (1994). Section 107 also sets forth four nonexclusive factors that courts must examine to determine whether a particular unauthorized use is fair. *Stewart v. Abend*, 495 U.S. 207, 236-37 (1990); *Harper & Row*, 471 U.S. at 549. The four statutory factors may not “be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.” *Campbell*, 510 U.S. at 578 (citation omitted).

B. Factor 1: The purpose and character of the use

The first statutory fair use factor strongly supports a finding of fair use for unlicensed copying and distribution of NPL that is necessary and incidental to the prosecution of a U.S. patent application (or to other USPTO proceedings concerning the patentability of an issued patent), including copies actually submitted and copies initially considered but not submitted. As explained above, patent prosecution and other USPTO patentability proceedings are imbued with the public good in accordance with the constitutionally-sanctioned goal “[t]o promote the Progress of Science and the useful Arts.” U.S. Const. art. I, § 8, cl. 8. Patent attorneys, while typically charging a fee for their services, do not profit either directly or indirectly from copying the NPL they identify and assess, and ultimately, if deemed material, submit to the USPTO. (Winstead’s motion to dismiss confirms this. *See* Doc. No. 56, at pp. 8-10.) And prior art NPL is submitted to the USPTO neither to supersede the original NPL in the marketplace nor for its original purpose of disclosing new information, but to show what information was known at the time of the applicant’s alleged invention to permit the USPTO to determine if the alleged invention was, at that time, novel and nonobvious. Under USPTO regulations, copies of all material NPL are typically included as part of the larger and more comprehensive IDS. As explained in more detail below, these circumstances strongly support a finding of fair use.

It is not enough simply to find that a patent applicant or his law firm is engaged in for-profit activities. “For a commercial use to weigh heavily against a finding of fair use, it must involve more than simply publication in a profit-making venture.” *Núñez v. Caribbean Int’l News Corp.*, 235 F.3d 18, 22 (1st Cir. 2000) (citations and footnote omitted). Thus, where the accused infringer gains no direct or immediate commercial advantage from its use of the copies, this factor weighs in favor of fair use. *See, e.g., Bouchat v. Baltimore Ravens L.P.*, 619 F.3d 301, 314 (4th Cir. 2010) (“It is appropriate to evaluate the use’s commercial status on its own terms.

Here, the Ravens were not gaining direct or immediate commercial advantage from the depictions of the logo in the lobby, *i.e.*, the team's profits, revenues, and overall commercial performance were not tied to this use. At bottom, we find no commercial use because no fee is charged to view the displays in the lobby of the Ravens corporate headquarters.") (citations, internal quotation marks, and brackets omitted). Here, as explained in Winstead's motion, Winstead treats the making of copies as an expense it incurs in providing its legal services, and simply obtains the agreement of its clients to pay for the estimated costs it incurred in connection with the number of pages copied. Reimbursement of the copy costs it incurs does not vary with the facts or expression appearing on the pages—one copied page of a one-sentence email produced in discovery costs the same as one copied page from an NPL article.

Rather than mandate the oversimplistic commercial versus non-commercial test, the Supreme Court has stated that the "central purpose" of a court's assessment of the first fair use factor is to determine:

whether the new work merely supersedes the objects of the original creation, or instead adds something new, with a further purpose or different character altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is "transformative." Although such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.

Campbell, 510 U.S. at 579 (citations, internal quotes, brackets, and footnote omitted).

"A 'transformative' use is one that 'employ[s] the quoted matter in a different manner or for a different purpose from the original,' thus transforming it." *A.V. ex rel. Vanderhye v.*

iParadigms, LLC, 562 F.3d 630, 638 (4th Cir. 2009) (citation omitted). Courts have held that the

“use of a copyrighted work need not alter or augment the work to be transformative in nature. Rather, it can be transformative in function or purpose without altering or actually adding to the original work.” *Id.* at 639 (citation omitted); *accord Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (“[E]ven making an exact copy of a work may be transformative so long as the copy serves a different function than the original work. . . . Here, Google uses Perfect 10’s images in a new context to serve a different purpose.”) (citation omitted); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 819 (9th Cir. 2003) (“This case involves more than merely a retransmission of Kelly’s images in a different medium. Arriba’s use of the images serves a different function than Kelly’s use. . . . Because Arriba’s use is not superseding Kelly’s use but, rather, has created a different purpose for the images, Arriba’s use is transformative.”).

Here, participants in USPTO patent proceedings do not copy NPL for the intrinsic purpose for which it was initially written and published; they are not copying it “with a view . . . to supersede the use of the original work” with a substitute (*Folsom v. Marsh*, 9 F. Cas. 342 (C.C.Mass., 1841) (Story, J.)). Rather, they copy it to potentially submit it to the USPTO, a determination which involves participants using these copies to facilitate the discussion and determination of whether a given work of NPL meets the “material to patentability” requirement. This is a determination that the patent statute and regulations require to be made before a patent can be granted. Further, this determination is not the original purpose of the NPL. An instructive analogy can be made to hearsay: an author’s original publishing of the NPL is typically made for the truth of the matter; a law firm’s later disclosure of NPL in conjunction with patent filings is *not* for the truth of the matter, but to memorialize that, at the time of publication, the material therein, *true or not*, had been disclosed to those in the art, *i.e.*, to provide the background for the alleged invention. *Cf. United States v. Castro-Lara*, 970 F.2d

976, 981 (1st Cir. 1992) (testimony offered not for the truth of the matter but for the different “purpose of providing relevant context or background” is not hearsay). This analogy clearly illuminates the different purpose NPL serves in the patent context.

Applicants’ copying of NPL is also performed as part of the process of adding new information to the NPL. Specifically, NPL deemed material, and therefore required to be disclosed to the USPTO, is typically integrated into a larger IDS or other multi-document application-related submission to the USPTO. The USPTO regulations encourage Applicants to submit an IDS (37 CFR § 1.51(d)) and further require that any IDS attach copies of the material NPL. *See* 37 CFR § 1.98(a)(2)(ii).⁴ As such, to the extent that the addition of “something new” (*Campbell*, at 510 U.S. at 579) may be required for a finding of transformative use, submission of NPL in connection with USPTO patent proceedings concerning patentability would meet that requirement. In short, Applicants’ use of the NPL is not submitted to publicly announce whatever it discloses (that, obviously, already occurred), but to provide, along with other patents and publications, the background context against which the USPTO measures the novelty and nonobviousness of the alleged invention—a process that clearly promotes the “useful arts.” *See* *Cotropia*, at p. 749 (“Society benefits when quality patents issue.”). To see how Applicants make a transformative use of NPL in this context, it is useful to use the words of the First Circuit in the *Núñez* decision, substituting in the context here in brackets:

Rather, what is important here is that plaintiffs’ [articles] were originally intended to appear in [scientific journals], not in [patent applications]; the former use, not the latter, motivated the creation of the work. Thus, by using the [articles] in conjunction with [a patent application and IDS disclosing the material prior art], [patent applicants and their attorneys] did not merely supersede the

⁴ For NPL written in a foreign language, the regulations further require Applicants to provide a “concise explanation of its relevance” to the alleged invention. *See* 37 CFR § 1.98(a)(3)(i).

objects of the original creations, but instead used the works for a further purpose, giving them a new meaning, or message.

Núñez, 235 F.3d at 23 (citations, internal quotation marks, and original brackets omitted)

And as mentioned earlier, the fact that the copies are being submitted in connection with patent prosecution—that is, toward the constitutionally-enshrined public benefit of the furtherance of “the useful Arts”—further weighs in favor of a finding of fair use. *See, e.g., Sundeman*, 142 F.3d at 203 (“Courts should also consider the public benefit resulting from a particular use notwithstanding the fact that the alleged infringer may gain commercially. This public benefit typically involves the development of art, science, and industry.”) (citations, internal quotation marks omitted).

Finally, it is clear that Applicants, the USPTO, and the public benefit from accuracy in determining patentability. It is far easier to determine whether an alleged invention is novel and nonobvious when Applicants and the USPTO can efficiently and simultaneously view the pertinent prior art than when they cannot actually view it and instead can only paraphrase it. And the resulting efficiency and accuracy in patent issuance benefits the public. *Cf. Núñez*, 235 F.3d at 22 (“It would have been much more difficult to explain the controversy without reproducing the photographs. And although such an explanatory need does not always result in a fair use finding, it weighs in the favor of [a finding of fair use].”) (citation omitted).

If any confirmation that this first factor weighs in favor of fair use were needed, it is highly significant that courts have uniformly found fair use when copyrighted materials are used without permission in government proceedings. For example, in *Bond v. Blum*, 317 F.3d 385 (4th Cir. 2003), a private investigator made multiple copies of an unpublished autobiography for use in court child custody proceedings by a private litigant and his private attorneys. The Fourth Circuit found fair use in these circumstances. *Id.* at 395-97.

The result was the same in *Religious Tech. Center v. Wollersheim*, 971 F.2d 364 (9th Cir. 1992), where the Ninth Circuit found fair use when private attorneys copied allegedly stolen religious documents and used them to prepare expert witnesses to testify in state tort litigation—even though the copies were not introduced into evidence. *See id.* at 367; *see also Hollander v. Swindells-Donovan*, No. 08-CV-4045, 2010 WL 844588 (E.D.N.Y. Mar. 11, 2010) (use of adversary’s copyrighted essays as evidence against him was fair use); *Moran v. Designit Int’l*, 557 F. Supp. 2d 378, 386-87 (W.D.N.Y. 2008) (use of copyrighted software provided by adverse party in discovery to view documents produced in discovery by that party is fair use); *Healthcare Advocates, Inc. v. Harding, Early, Follmer & Frailey*, 497 F. Supp. 2d 627, 636-39 (E.D. Pa. 2007) (fair use where law firm made copies of plaintiff’s web pages for use in connection with defense of its client against plaintiff’s charges of trademark infringement); *Shell v. DeVries*, No. 06-cv-00318-REB, 2007 WL 324592 (D. Colo. Jan. 31, 2007) (fair use where a party made copies of its adversary’s copyrighted webpages in litigation), *aff’d*, No. 07-1086, 2007 WL 4269047 (10th Cir. Dec. 6, 2007) (unpublished); *Lucent Information Mgmt., Inc. v. Lucent Techs., Inc.*, 5 F. Supp. 2d 238, 242-43 (D. Del. 1998) (use of litigation adversary’s copyrighted letter to conduct litigation survey is fair use)⁵.

⁵ Cf. *Images Audio Visual Prod., Inc. v. Perini Bldg. Co.*, 91 F. Supp. 2d 1075 (E.D. Mich. 2000). *Images Audio Visual* presented a unique factual context not present here. In that case, the plaintiff photographer took photos of a construction site for the defendant builder to use in case litigation arose between the builder and the party contracting for the construction. When the builder sued the contracting party for non-payment, the builder sought permission from the photographer to use the photos in the litigation. When the photographer quoted high prices for additional copies, the builder simply made the copies itself. The photographer then sued the builder for breach of contract and copyright infringement. The court found no fair use primarily because the photos *were created for the express purpose of being used by the builder in construction litigation*. *Id.* at 1086-87. This fact not only explains why this decision came out differently than the above-cited decisions, it fully distinguishes the decision from the instant dispute, since there is no allegation that the defendant law firm contracted with the plaintiffs to write the articles at issue for use in connection with patent applications.

Jartech, Inc. v. Clancy, 666 F.2d 403, 406-07 (9th Cir. 1982) found fair use when city officials surreptitiously took photographs of films being shown in an adult theatre and used them in a nuisance abatement hearing. And police were held to have made fair use when they seized published and unpublished photographs from a photographer's studio, made copies of many of them in a murder investigation, but ultimately included only copies of some of them in the official investigation notebook. *See Shell*, 351 F. Supp. 2d at 512-13.

Thus, courts have held that use of copyrighted materials in connection with government proceedings as diverse as private civil litigation, public nuisance hearings, and criminal investigations, is fair use—and not just when those copies were actually submitted in official proceedings, but even for unsubmitted copies that were incidental to the process at issue.

In sum, the first factor favors fair use when USPTO participants do not profit directly from the accused copying, but rather use the copies to the further benefit of society as a whole in the patent prosecution process. The copies are made with the goal of identifying NPL that is material to the claimed invention and integrating it into an IDS, which the USPTO uses to determine the patentability of the claimed invention. This use does not “merely supersede[] the objects of the original creation,” but “instead adds something new, with a further purpose or different character altering the first with new expression, meaning, or message.” *See Campbell*, 510 U.S. at 579. And the making of these copies facilitates the efficiency and accuracy of the patent prosecution process—a repeatedly acknowledged public benefit. In short, there can be no doubt that the first factor strongly favors fair use.

C. Factor 2: The nature of the copyrighted work

The works at issue here are published, factual works, and Applicants and the patent system care only about the facts disclosed, not the way they are disclosed (*i.e.*, creative

expression of the facts is immaterial), and the fact that these articles have been published. As a consequence, this factor weighs exclusively in favor of fair use.

The Supreme Court has described this factor as drawing:

on Justice Story's expression, the "value of the materials used." This factor calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied. *See, e.g., Stewart v. Abend*, 495 U.S., at 237-38, 110 S. Ct., at 1768-1769 (contrasting fictional short story with factual works)

Campbell, 510 U.S. at 586 (further citations omitted).

Specifically, "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." *Harper & Row*, 471 U.S. at 563 (citation omitted). Thus "[i]n general, fair use is more likely to be found in factual works than in fictional works." *Stewart*, 495 U.S. at 237 (citations omitted); *accord Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 410 (5th Cir. 2004).

Here, the Amended Complaint makes clear that these are factual works. In addition, these works have already been published—and the articles are relevant to patentability precisely because they have been published. There is therefore no issue of usurping the author's important right of deciding when and how to first publish. *See Harper & Row*, 471 U.S. at 564 ("[T]he scope of fair use is narrower with respect to unpublished works."); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003) ("[p]ublished works are more likely to qualify as fair use because the first appearance of the artist's expression has already occurred." (footnote omitted)).

Because NPL is factual and has previously been published, this factor favors fair use.

D. Factor 3: The amount and substantiality of the portion used

"The third factor asks whether 'the amount and substantiality of the portion used in relation to the copyrighted work as a whole,' (or, in Justice Story's words, 'the quantity and value

of the materials used,') are reasonable in relation to the purpose of the copying." *Campbell*, 510 U.S. at 586 (citations omitted); *see also Kelly*, 336 F.3d at 820-21 ("[T]he extent of permissible copying varies with the purpose and character of the use. If the secondary user only copies as much as is necessary for his or her intended use, then this factor will not weigh against him or her.") (footnote omitted).

For purposes of this motion, the USPTO will assume that the Amended Complaint's allegations—that the protected articles appear, together with other articles, in plaintiffs' scientific and technical periodicals, and that Applicants copy entire articles for purpose of patent prosecution—is true. But as the Supreme Court has noted, "the extent of permissible copying varies with the purpose and character of the use." *Campbell*, 510 U.S. at 586-87. And here, the purpose and character of the use reveals that participants in USPTO proceedings do not copy articles to compete with the plaintiffs or exploit the works directly, but to fulfill their obligation to the USPTO or to assist the USPTO in patent-related proceedings. Further, the articles are copied for their factual content, not any protectable expression, and the USPTO uses the facts disclosed to assess the patentability of the alleged invention.

Given these circumstances, it is abundantly clear that Applicants who copy NPL articles for purposes necessary and incidental to USPTO proceedings take no more than is necessary for the beneficial governmental purpose for which the articles are to be used. This factor thus does not weigh against fair use. At worst it is neutral. *See Bond*, 317 F.3d at 396 (In a case involving courtroom use of a litigant's manuscript as evidence, the court stated: "Its use, however, was not for its expressive content, but rather for its allegedly factual content. . . . The use of the copyrighted material in this context, *even the entire manuscript*, does not undermine the protections granted by the Act but only serves the important societal interest in having evidence

before the factfinder. Because the manuscript was not used to undermine any right conferred by the Copyright Act, Bond can derive little benefit from this factor in the context of this case.”) (emphasis added); *see also Bouchat*, 619 F.3d at 315 (use of entire copyrighted logo was “neutral” where “the amount copied [was] justified in relation to the transformative purpose behind the use”); *Perfect 10*, 508 F.3d at 1167-68 (use of entire copyrighted photo as a digital thumbnail to link to the original image “favored neither party” where use of the entire image “was reasonable in light of the purpose of a search engine”); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (use of entire copyrighted concert promotion posters, reduced in size, in historical book about a rock band did “not weigh against fair use” given the transformative purpose to which the posters were put).

E. Factor 4: The effect on the potential market or value of the copyrighted work

“The fourth fair use factor is ‘the effect of the use upon the potential market for or value of the copyrighted work.’ It requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also ‘whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market’ for the original.” *Campbell*, 510 U.S. at 590 (citations omitted). “Market harm is a matter of degree, and the importance of this factor will vary, not only with the amount of harm, but also with the relative strength of the showing on the other factors.” *Id.* at 590 n.21.

In analyzing this factor, courts should “balance the benefit the public will derive if the use is permitted and the personal gain the copyright owner will receive if the use is denied.” *Wright v. Warner Books, Inc.*, 953 F.2d 731, 739 (2d Cir. 1991) (citations and internal quotation marks omitted). “The less adverse impact on the owner, the less public benefit need be shown to sustain non-commercial fair use.” *Rogers v. Koons*, 960 F.2d 301, 311-12 (2d Cir. 1992). In

assessing market impact, evidence that an accused infringer did not pay for its use of the work does not demonstrate market harm. *See, e.g., Bill Graham Archives*, 448 F.3d at 614. Otherwise, the fourth factor would favor the copyright holder in every case. *See id.* In addition, the Supreme Court has said that “a use that has no demonstrable effect upon the potential market for, or the value of, the copyrighted work need not be prohibited in order to protect the author’s incentive to create. The prohibition of such noncommercial uses would merely inhibit access to ideas without any countervailing benefit.” *Sony Corp. of Amer. v. Universal City Studios, Inc.*, 464 U.S. 417, 450-51 (1984) (footnote omitted); *see also Harper & Row*, 471 U.S. at 566-67 (“Fair use, when properly applied, is limited to copying by others which does not *materially impair the marketability of the work* which is copied.”) (citation omitted; emphasis added)).

The issue amounts to an assessment of market replacement or market substitution, and from this formulation of the issue, two principles flow: “when a commercial use amounts to mere duplication of the entirety of an original, it clearly ‘supersedes the objects’ of the original and serves as a *market replacement* for it, making it likely that cognizable market harm to the original will occur. But when, on the contrary, the second use is transformative, *market substitution* is at least less certain, and market harm may not be so readily inferred.” *Campbell*, 510 U.S. at 591 (citations omitted; brackets and emphasis added).

In this case, it is beyond dispute that minimizing the costs, degree of difficulty, and accuracy of the U.S. patent system benefits the public, and that requiring participants in USPTO proceedings and their lawyers to identify all relevant copyright holders, seek permission to copy, and then pay royalties each time they identify and assess a potentially material prior art article would hinder patent proceedings and make them more expensive.

Further, there is no indication in the Amended Complaint, or in any comments made by plaintiffs' counsel in the November 20, 2012, hearing, that suggest that the publishers or authors create and publish these works to exploit the "market" for submitting articles in connection with patent proceedings. Neither does the amended complaint claim that the defendants are re-selling copies of the NPL. And there are no allegations that the USPTO makes these articles freely available to third parties once filed, because it does not. In these circumstances, it simply cannot be said that the copies allegedly made by the law firm serve as a "market replacement" or "market substitute" for the original.⁶ And because Applicants integrate the copies of required NPL into a larger submission (in the prosecution process, usually the IDS), for the purpose of providing the background needed by the USPTO to determine the patentability of the alleged invention, they make a transformative use of the NPL, which in turn points away from any inference that the use serves as a market substitute for the original publication.

In short, the fourth factor favors fair use, and strongly, for copies made of NPL that are necessary and incidental to proceedings before the USPTO.

F. Weighing the Four Factors

Here, the first, second, and fourth factors decisively favor fair use for copies of NPL that are necessary and incidental to proceedings before the USPTO. The third factor is neutral, at

⁶ Even if some law firms have requested authorization and paid royalties to the Copyright Clearance Center (CCC) to copy NPL that may fall within its scope to use it, for example, in connection with USPTO proceedings, that would not show material impairment to the market for the original. Although often relevant to the fair use analysis, the mere fact that licenses may be available for the works at issue does not preclude a finding of fair use. As stated in *Bill Graham Archives*, 448 F.3d at 614-15, "[i]n a case such as this, a copyright holder cannot prevent others from entering fair use markets merely by developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work. Copyright owners may not preempt exploitation of transformative markets." (citations, footnotes, brackets, and internal quotation marks omitted). In this case, that licenses are available for only some, but not all, of the works at issue further diminishes the relevance a CCC license to the fair use analysis.

worst. This alone supports judgment in favor of the USPTO on fair use defense and counterclaim.

As mentioned, however, these factors are not exclusive. *See, e.g., Stewart*, 495 U.S. at 236-37 (1990); *Harper & Row*, 471 U.S. at 549. In weighing the statutory fair use factors and assessing whether an alleged infringing act is protected fair use, courts frequently take into account the whether the challenged activity yields a societal benefit. *See, e.g., Sundeman v. Seajay Soc'y, Inc.*, 142 F.3d 194, 203 (4th Cir. 1998) (“Courts should also consider the public benefit resulting from a particular use notwithstanding the fact that the alleged infringer may gain commercially. This public benefit typically involves the development of art, science, and industry.”) (citations, internal quotation marks omitted); *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1523 (9th Cir. 1992) (“[W]e are free to consider the public benefit resulting from a particular use notwithstanding the fact that the alleged infringer may gain commercially. Public benefit need not be direct or tangible, but may arise because the challenged use serves a public interest.”) (citations omitted); *Pacific and Southern Co. v. Duncan*, 744 F.2d 1490, 1495 (11th Cir. 1984) (“Where strict enforcement of the rights of a copyright holder . . . would conflict with the purpose of copyright law or with some other important societal value, courts should be free to fashion an appropriate fair use exemption.”); *see also Sony Corp.*, 464 U.S. at 429 (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved.”); *id.* at 454 (“the fact that to the extent time-shifting expands public access to freely broadcast television programs, it yields societal benefits”).

Here, the very provision of the Constitution that gives Congress the power to enact copyright legislation expressly extolls the benefits of an efficient patent system. It provides that

“Congress shall have the Power . . . To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. art. I, § 8, cl. 8.⁷ See generally *Harper & Row*, 471 U.S. at 549 (“[T]he author’s consent to a reasonable use of his copyrighted works ha[d] always been implied by the courts as a necessary incident of the constitutional policy of promoting the progress of science and the useful arts . . .”) (citation omitted). As the Supreme Court has stated: “The primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’” *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (citation omitted); see also *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) (“The copyright law, like the patent statutes, makes reward to the owner a secondary consideration” to the general benefits derived by the public from these laws.). Accordingly, courts have noted that “[t]he ultimate test of fair use is whether the copyright law’s goal of ‘promoting the Progress of Science and useful Arts,’ would be better served by allowing the use than by preventing it.” *Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006) (citations, ellipses, and internal quotation marks omitted); accord *Bill Graham Archives*, 448 F.3d at 608.

The foregoing precepts make clear that a court assessing and weighing the four statutory fair use factors should be cognizant that copying that is necessary and incidental to government patent proceedings promotes a recognized societal benefit: Facilitating full disclosure of known prior art will assist the examination of patent applications and issued patents for patentability, see *Cotropia*, at pp. 754-55, which leads to high-quality patents and therefore promotes the “useful Arts.” See 37 CFR § 1.56(a). When patent applicants, for example, determine whether a

⁷ Many observers believe that the Framers of the Constitution understood “Science” to refer to copyrightable works and “useful Arts” to refer to patentable inventions. See 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 1.03 n.11.2 (2010).

particular item of prior art should be submitted to the USPTO, one issue that they often encounter is that a particular item of prior art may be material if considered alone, but it is not if it is merely cumulative to, or less relevant than, information already considered by the examiner. *Larson Mfg. Co. v. Aluminart Prods. Ltd.*, 559 F.3d 1317, 1327 (Fed. Cir. 2009); *see also* 37 C.F.R. § 1.56(b) (2008) (“[I]nformation is material to patentability when it is not cumulative of information already of record or being made of record in the application”). Thus, an applicant has no duty to disclose otherwise material prior art if it is merely cumulative to, or less relevant than, information already before the examiner. *Larson Mfg.*, 559 F.3d at 1327. As noted in the context of discovery, hiding a “needle in a haystack” can be as contrary to an obligation of full and frank disclosure as withholding pertinent information. *See, e.g., Hagemeyer N. Amer., Inc. v. Gateway Data Sciences Corp.*, 222 F.R.D. 594, 598 (E.D. Wisc. 2004) (“When producing documents, the responding party cannot attempt to hide a needle in a haystack by mingling responsive documents with large numbers of nonresponsive documents.”); *cf. Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) (“bury[ing] PTO examiners with a deluge of prior art references, most of which have marginal value” without “meaningfully consider[ing]” their materiality leads to “strained PTO resources, increased PTO backlog, and impaired patent quality”) (en banc). Thus, there is public benefit in incentivizing applicants and practitioners to conduct a careful assessment of the prior art and submit the necessary information to the USPTO without inundating examiners with unnecessary documentation.

In sum, the Constitution itself puts the importance to society of issuing high-quality patents on equal footing with copyrights. And through all of the above-explained statutes and regulations, Congress and the USPTO have made clear the importance of identifying and submitting NPL in the determination of whether the USPTO should grant a patent applicant a

patent and whether, upon challenge by a third party, any issued patent should continue in effect. Thus, the societal benefit of high-quality patents only confirms that the fair use factors discussed above favor fair use.

CONCLUSION

Fair use plainly encompasses use of copyrighted NPL where: Applicants make necessary and incidental copies of published factual articles for the facts they disclose in connection with Constitutionally-sanctioned patent proceedings before the USPTO in which the applicable regulations mandate disclosure of material prior art publications in order to ensure that the USPTO can efficiently make decisions that comport with the Constitutional and statutory requirements for patentability.

Date: 2/27/13

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing instrument was served upon counsel of record on February 27, 2013, through the CM/ECF system in accordance with the Federal Rules of Civil Procedures and this District's Local Rules.

/s/ Tami C. Parker

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